

REMARKS

Claims 1, 3-4, 9 and 12-13 were examined in the Office Action mailed July 11, 2008. The following objections and rejections are pending:

- Objection to lack of identification of the foreign priority application in the Oath/Declaration.
- Rejection of claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. US 2004/0094522 (“Hermann”).
- Rejection of claims 3-4 under § 103(a) as unpatentable over Hermann, in view of Japanese patent document JP 10-296472 (“Goto”).

In response to the Examiner’s remarks regarding the transition phrase “consisting essentially of,” the Applicant has amended independent claim 1 to recite “consisting of.” As noted in the MPEP, the transitional phrase “consisting of” “excludes any element, step, or ingredient not specified in the claim.” MPEP § 2111.03 (citing *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931) and *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“consisting of” defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.”)).

In addition, although the Applicant maintains that the preamble of claim 1 and the Applicant’s previous remarks make it clear that the claims are directed to non-ferrous metal laser welding, claim 1 has also been amended to recite in the “guiding at least one focused laser” limitation that the laser is guided “to a nonferrous workpiece surface to be machined.” As noted in the original Specification, while certain gases have been used with various steels (including coated steels), previously welding with lasers “ha[d] not been successful in practice for laser welding of *nonferrous* metals,” where “[i]nsufficient laser welds

occurred, particularly with low welding depths.” Specification ¶¶ [0010]-[0011] (emphasis added). The Applicant determined, “[s]urprising,” that contrary to the prior experience in the art, a gas containing carbon dioxide “can act as parameters influencing the welding process and result in a high-quality laser welding at a high laser speed,” where the carbon dioxide “results in an extremely good coupling-in of energy” and “surprisingly, laser welding processes can be carried out without any local overheating of the workpiece.” *Id.* ¶¶ [0016], [0018].

1. The Claims Are Patentable Over Hermann and Goto. Both of the Hermann and Goto references disclose welding of *steels*, not the recited nonferrous materials. Hermann Abstract (“The invention is suitable for laser welding of low-alloy steels and coated, especially zinc-coated steels). The Goto reference is cited as disclosing “welding of an aluminum tank,” but this is not correct. Both the title and abstract of Goto state that this reference is directed to welding of “aluminum-plated steel sheet” – *i.e.*, a corrosion-inhibiting coating similar to Hermann’s zinc-plated steel which is instantly burned off (and therefore not significant to the welding of the underlying target steel plate). Thus, because both references disclose gases suitable for use with *ferrous* material welding, both fail to disclose or suggest solutions for the prior art’s problems in laser welding of *nonferrous* materials.

As one of ordinary skill in the art recognizes, even between different *steel* materials, differences in alloy composition can radically change the welding performance of a welding processes. Accordingly, the use of one gas composition

with one alloy would not suggest the suitability of the gas with another alloy – let alone the use of a gas used for steel welding with a *completely different* class of materials – in the present case, *nonferrous* materials (such as “aluminum materials and alloys, magnesium materials and alloys, nickel base materials and alloys and/or brass-containing materials”; Specification ¶ [0015]).

Because Hermann and Goto do not disclose or suggest the claim 1 process and its specific process gas compositions, and further because these references disclose *steel* welding gases which do not provide teachings for suggests for laser welding of *nonferrous* materials, the Applicant submits that the pending claims are patentable over these references under § 103(a).

Reconsideration and withdrawal of the rejections based on the Hermann and Goto references is respectfully requested.

2. The Rules Do Not Require An Oath As To Priority. In accordance with the suggestion of the Examiner’s supervisor in the telephone interview conducted September 2, 2008, for the purposes of preserving the issue the record the Applicant restates below his previous comments regarding the pending objection to the oath/declaration as not identifying the foreign priority application by application number, country, day, month and year of filing.

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Restatement for the Record. In the Applicant’s October 31, 2007 response, it was noted that 37 C.F.R. expressly does not require what the Examiner is currently seeking. As noted in that response:

The Applicant respectfully draws the Examiner's attention to the provisions of 37 C.F.R. § 1.63(c). This rule subsection explicitly states that the oath or declaration must identify any foreign application for patent for which priority is made "UNLESS such information is supplied on an application data sheet in accordance with § 1.76." (emphasis added). This is precisely how the Applicant provided the required priority information – in the ADS, not in the declaration, as permitted.

The Applicant further notes that there is no requirement in the rules that foreign priority data be attested to in the form of a formal oath or declaration (whether it is included with the rest of the information required in an oath/declaration, or it is included in an ADS). Indeed, this is what § 1.63 plainly contemplates, as nothing in § 1.63 (or in § 1.76, the ADS rule) begins to suggest the need for an oath for either the priority information or an application data sheet. Finally, the Applicant respectfully draws the Examiner's attention to the fact that the form of submission of priority information in this case – in the ADS, not the declaration – is exactly the way priority information has been presented to the Office in untold thousands of patent applications over the years.

Based on the September 2, 2008 telephone interview, it is the Applicant's understanding that this issue has been resolved, that the Applicant's originally-filed Application Data Sheet is satisfactory for the purpose of meeting the foreign priority claim documentation, and that the pending objection to the oath/declaration will be withdrawn. The consideration of the Examiner and the Examiner's supervisor in this matter is appreciated.

CONCLUSION

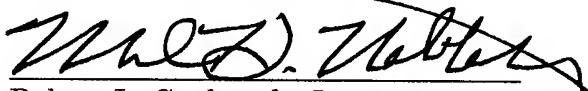
In view of the foregoing, the Applicant respectfully submits that claims 1, 3-4, 9 and 12-13 are in condition for allowance. Early and favorable consideration and issuance of a Notice of Allowance for these claims is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #038724.52699US).

Respectfully submitted,

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